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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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John p. Ruckart

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EXAMINER

HASHEM, LISA

ART UNIT

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2614

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/086,338	Applicant(s) RUCKART, JOHN P.	
	Examiner Lisa Hashem	Art Unit 2614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 September 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 6-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 6-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 9-11-07 have been fully considered but they are not persuasive.

Applicant argues that Miner does not teach: 'a user input predetermined time period', 'if the hold function is not enabled, directly ringing a called party device', and 'if the hold function is enabled, automatically answering'.

Examiner disagrees. Miner discloses a user can determine when to accept or decline calls based on time, schedule, day of week, time of day, etc (col. 4, lines 16-26). Miner discloses a if there is no call screening set then directly ringing a called party device (i.e. subscriber's desk phone), and if there is call screening set, then automatically answering the call by the electronic assistant (col. 32, line 54 – col. 33, line 4; col. 33, lines 14-23). Thus, Miner still discloses the claimed invention because Miner discloses the subscriber delegates parameters of a call screening function or call hold function and if it is not set, directly forwarding the call to a subscriber's device and if it is set, placing the call on hold and retrieving parameters on how to handle the call (i.e. locate subscriber and then forward call, send call to voicemail, ask for caller's identity; etc). The call handling method functions according to the subscriber's preferences.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 6-13 and 17-22 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by U.S. Patent No. 5,652,789 by Miner et al, hereinafter Miner.

Regarding claim 6, Miner discloses a method of handling an incoming call to a telecommunications device (col. 20, lines 40-50; col. 29, lines 17-21; col. 30, lines 51-60; col. 32, lines 1-47) from a calling party to a called party, the method comprising: receiving one or more parameters of a hold function, wherein the parameters include at least one of a user input predetermined time period (e.g. during an existing call of a called party the called party will accept interruptions; a time when the called party is online) (col. 4, lines 16-26) during which the incoming call is placed on hold, (e.g. waiting on the line for the called party to establish connection with the called party when the called party will accept interruptions) (col. 4, lines 16-26; col. 5, lines 47-57; col. 8, lines 25-59; col. 37, lines 38-56), and a list (e.g. calling party's contact list) including at least one predetermined potential calling party (e.g. caller with high priority) from whom incoming calls are placed on hold (e.g. waiting on the line to connect with the called party when the called party is on another call or is online) (col. 8, lines 10-20; col. 32, line 65 – col. 33, line 54);

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if the hold function is not enabled, directly ringing a called party device (col. 32, line 54 – col.

33, line 4; directly forward call based on preferences of subscriber);

if the hold function is enabled (e.g. the called party wants calls screened; col. 33, lines 14-23),

automatically answering the call (e.g. establishing connection to the called party; called party

being notified of incoming call; called party accepts the call) if the call corresponds to the one or

more parameters of the hold function and placing the call on hold (e.g. not disconnecting the call;

call stored in queue; holding the call until the called party becomes available) (col. 32, lines 46-

64; col. 33, lines 5-17 and lines 49-54; col. 34, lines 20-33 and lines 60-65; Fig. 24A: 500, 504,

516, 518, 522, 524, 528; col. 37, line 38-67);

playing a message to the calling party that the call has been placed on hold (col. 8, lines 50-59;

col. 34, lines 8-12) and

connecting the called party to the calling party when the called party answers the call (col. 8,

lines 50-59; col. 36, lines 44-51; Fig. 26: 614, 622; col. 37, lines 38-63; col. 38, lines 1-14 and

lines 27-29; Fig. 24A: 524, 528; Fig. 27: 640, 644).

Regarding claim 7, the method of claim 6, wherein Miner further discloses determining whether the called party has enabled a hold function (col. 7, lines 51-65; col. 32, lines 54-64; col. 33, lines 14-54; col. 34, lines 60-65; col. 37, line 38 – col. 39, line 3).

Regarding claim 8, the method of claim 6, wherein Miner further discloses determining whether the called party has pressed a button on the telecommunications device to enable a hold function (col. 8, lines 36-59; col. 37, line 54 – col. 38, line 3).

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Regarding claim 9, the method of claim 6, wherein Miner further discloses means for alerting the called party of the incoming call (col. 8, line 10-59; col. 36, lines 44-49; col. 38, lines 1-26).

Regarding claim 10, the method of claim 6, wherein Miner further discloses connecting the calling party to a voicemail system when the called party does not answer the call within a predetermined time period (col. 8, lines 60-63; col. 38, lines 15-26).

Regarding claim 11, the method of claim 6, wherein Miner further discloses playing a message to the calling party includes playing a message that is resident on a services node (e.g. a virtual machine) of a telecommunications network (Figs. 3 and 5) (col. 20, lines 40-50; col. 38, lines 15-26).

Regarding claim 12, the method of claim 6, wherein Miner further discloses playing a message to the calling party includes playing a pre-recorded message stored in a memory device resident on the telecommunications device (e.g. a virtual machine) (col. 8, lines 55-59; col. 20, lines 40-50; col. 38, lines 15-26).

Regarding claim 13, the method of claim 6, wherein Miner further discloses connecting the call to a voicemail system when the called party presses a button on the telecommunications device (col. 8, lines 60-63; col. 36, lines 47-60).

Regarding claim 21, the method of claim 6, wherein Miner further discloses the receiving one or more parameters of the hold function is performed via a web interface (col. 10, line 51 – col. 11, line 3; col. 11, lines 51-63; col. 16, lines 47-60; col. 17, lines 31-59; col. 19, lines 53-61; col. 33, lines 29-48; col. 37, lines 54-63).

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Regarding claim 17, Miner discloses an apparatus (col. 20, lines 40-50; col. 29, lines 17-21; col. 30, lines 51-60; col. 32, lines 1-47), comprising:

means for receiving one or more parameters of a hold function,

wherein said parameters include at least one user input predetermined time period (e.g. during an existing call of a called party the called party will accept interruptions; a time when the called party is online) (col. 4, lines 16-26) during which an incoming call is placed on hold (e.g. waiting on the line for the called party to establish connection with the called party when the called party will accept interruptions) (col. 4, lines 16-26; col. 5, lines 47-57; col. 8, lines 25-29; col. 37, lines 38-56), and

a list (e.g. calling party's contact list) including at least one predetermined potential calling party (e.g. caller with high priority) from whom incoming calls are placed on hold (e.g. waiting on the line to connect with the called party when the called party is on another call or is online) (col. 8, lines 10-20; col. 32, line 65 – col. 33, line 54);

means for directly ringing a called party device if the hold function is not enabled (col. 32, line 54 – col. 33, line 4; directly forward call based on preferences of subscriber);

means for automatically answering a call placed by a calling party to a called party if the hold function is enabled (e.g. establishing connection to the called party; called party being notified of incoming call; called party accepts the call; the called party wants calls screened; col. 33, lines 14-23),

if the call corresponds to the one or more parameters and placing the call on hold (e.g. not disconnecting the call; call stored in queue; holding the call until the called party becomes

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available) (col. 32, lines 46-64; col. 33, lines 5-17 and lines 49-54; col. 34, lines 20-33 and lines 60-65; Fig. 24A: 500, 504, 516, 518, 522, 524, 528; col. 37, line 38-67);

means for playing a message to the calling party that the call has been placed on hold (col. 8, lines 50-59; col. 34, lines 8-12); and

means for connecting the called party to the calling party when the called party answers the call (col. 8, lines 50-59; col. 36, lines 44-51; Fig. 26: 614, 622; col. 37, lines 38-63; col. 38, lines 1-14 and lines 27-29; Fig. 24A: 524, 528; Fig. 27: 640, 644).

Regarding claim 18, the apparatus of claim 17, wherein Miner further discloses means for determining whether the called party has enabled a hold function (col. 7, lines 51-65; col. 32, lines 54-64; col. 33, lines 14-54; col. 34, lines 60-65; col. 37, line 38 – col. 39, line 3).

Regarding claim 19, the apparatus of claim 17, wherein Miner further discloses means for determining whether the called party has pressed a button on a telecommunications device to enable a hold function (col. 8, lines 36-59; col. 37, line 54 – col. 38, line 3).

Regarding claim 20, the apparatus of claim 17, wherein Miner further discloses means for alerting the called party of the incoming call (col. 8, lines 10-59; col. 36, lines 44-49; col. 38, lines 1-26).

Regarding claim 22, the apparatus of claim 17, wherein Miner further discloses the means for receiving one or more parameters of the hold function receives the one or more parameters via a web interface (col. 10, line 51 – col. 11, line 3; col. 11, lines 51-63; col. 16, lines 47-60; col. 17, lines 31-59; col. 19, lines 53-61; col. 33, lines 29-48; col. 37, lines 54-63).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 14-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Okun in view of Dutta.

Regarding claim 14, Okun discloses a telecommunications system (see Figure 1a; section 0013, lines 1-8), comprising a home location register (Figure 1A, 110) for storing a profile of a user of a telecommunications device (Figure 1A, 126), wherein the profile includes an indication of whether the user is a subscriber to an incoming call hold service implemented by the telecommunications system (e.g. a subscriber profile indicates determining whether a text or voice message is preferred for a calling party in order to send a message to a calling party that is on hold) (section 0014, lines 1-6; section 0036, lines 1-8; section 0039, line 1 – section 0040, line 11; section 0044, lines 1-14; section 0077, lines 1-12); a services node or serving MSC (Figure 1A, 118) for: directly ringing a called party device if the hold function is not enabled (col. 32, line 54 – col. 33, line 4; directly forward call based on preferences of subscriber); determining whether an incoming call placed to the telecommunications device by a calling party should be placed on hold prior to the call being answered by the user of the telecommunications device according to the incoming call hold service if the hold function is enabled (e.g. the called party wants calls screened; col. 33, lines 14-23), the determining based on a user input

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predetermined time period (an inopportune time period) (e.g. during an existing call of a called party the called party will accept interruptions; a time when the called party is online) (col. 4, lines 16-26) during which the incoming call is placed on hold (section 0011, lines 1-4); placing the incoming call on hold prior to the call being answered; playing a message to the calling party that the call has been placed on hold (section 0054, line 1 – section 0057, line 13); and connecting the telecommunications device to the calling party if the user of the telecommunications device answers the incoming call (section 0058, line 1 – section 0063, line 10); and a mobile switching center or originating MSC (Figure 1A, 102) for facilitating communication between the telecommunications device, the services node, and the home location register (section 0054, lines 5-12).

Okun clearly discloses determining whether an incoming call should be placed on hold prior to being answered. However, Okun does not disclose the determining based on a list including at least one predetermined potential calling party from whom incoming calls are placed on hold.

Dutta discloses a telecommunications system comprising:
a services node or Bluetooth server (col. 5, line 1 – col. 6, line 13; Figs. 5 and 6) for:
determining whether an incoming call placed to the telecommunications device by a calling party should be placed on hold prior to the call being answered by the user of the telecommunications device according to the incoming call hold service,
the determining based on at least one of a predetermined time period (e.g. when the user is in a theatre or concert hall and receives Bluetooth hold commands from a Bluetooth server; a timer is

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set up to detect the commands) during which the incoming call is placed on hold (col. 1, lines 29-37; col. 5, lines 25-33; col. 6, lines 2-13), and

a list including at least one predetermined potential calling party from whom incoming calls are placed on hold (col. 2, lines 21-36);

placing the incoming call on hold prior to the call being answered (col. 5, lines 7-14; col. 5, lines 60-67);

playing a message to the calling party that the call has been placed on hold; and

connecting the telecommunications device to the calling party if the user of the telecommunications device answers the incoming call (col. 5, line 60 - col. 6, line 2).

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify the telecommunication system of Okun to include the determining based on a list including at least one predetermined potential calling party from whom incoming calls are placed on hold as taught by Dutta. One of ordinary skill in the art would have been lead to make such a modification in a service node to process calls from a caller with high priority in order to take urgent calls and place the call on hold until the called party is able to take the call without disturbing others. Dutta is evidence that calls from high priority callers are placed on hold until the called party can receive the call without disturbing others during a time period when the incoming call hold feature is activated.

Regarding claim 15, the system of claim 14 mentioned above, wherein Okun further discloses the services node includes an enunciator or IVR (section 0057, lines 5-9; section 0061, lines 10-14).

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Regarding claim 16, the system of claim 15 mentioned above, wherein Okun further discloses the enunciator is for playing a message to a calling party when a call is placed on hold (section 0057, lines 5-9; section 0061, line 10 – section 0062, line 10).

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See PTO-892 Form.
7. Any response to this action should be mailed to:

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Or faxed to:

(571) 273-8300 (for formal communications intended for entry)

Or call:

(571) 272-2600 (for customer service assistance)

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lisa Hashem whose telephone number is (571) 272-7542. The examiner can normally be reached on M-F 8:30-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on (571) 272-7547. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-2600.

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9. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

lh

October 1, 2007



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